

Remarks

This amendment is in response to the Office Action dated September 24, 2003. Claims 11-15 have been canceled without prejudice, to expedite the application to allowance and in no way affects the applicants' right to pursue the patentability of the subject matter contained in these claims.

Rejections under 35 U.S.C. § 103, Butler in view of Zhu

Claims 1-4, 7-8, 10 and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over US 5,928,726 (Butler) in view of US 5,608,003 (Zhu). The office action stated:

“As for the particle size being at least 1 micron, it would have been obvious to modify Butler by providing particles of at least 1 micron size to optimize the surface texture.”

According to MPEP §2143.03:

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Claim 1 has been amended to incorporate the limitations of dependent claim 3.

Neither reference suggests that the particulate filler used in the low adhesion backsize layer (LAB) have a diameter that is greater than the thickness of the LAB coating layer, as specified in newly amended claim 1. Additionally, neither Butler nor Zhu suggest using particle size of at least 1 micron or greater in the layer of low adhesion backsize (LAB).

The missing elements are not taught or suggested in any prior art reference cited in the office action. Thus, the statement that modifying Butler by providing particles of at least 1 micron size to change the surface texture of the LAB is an improper use of hindsight by the Examiner. Since these elements are not taught in either of the references cited in the Office Action, prima facie obviousness has not been established and the rejection to claim 1 should be withdrawn. Reconsideration, allowance and notice to that effect are respectfully requested.

Dependent claims 2 and 4 depend from allowable independent claim 1 and are therefore allowable themselves. Due to their dependency on an allowable independent claim, any additional rejections are moot. The rejections to claims 2 and 4 are overcome and should be withdrawn. Reconsideration, notice and allowance to that effect is respectfully requested.

Independent claim 7 includes the limitation that the coated film includes a coated LAB containing particulate, where the particle size is at least 1 micron or greater. As discussed above with respect to claim 1, this element is not taught in either the Butler or Zhu references. Since all the elements of claim 7 are not taught or suggested alone or in combination by either the Butler or Zhu references, the rejection of independent claim 7 is improper and should be withdrawn. Reconsideration and notice to that effect are respectfully requested.

Dependent claims 8-10 depend from allowable independent claim 1 and are therefore allowable themselves. Due to their dependency on an allowable independent claim, any additional rejections are moot. The rejections to claims 2 and 4 are overcome and should be withdrawn. Reconsideration, notice and allowance to that effect is respectfully requested.

Independent claim 15 has been cancelled without prejudice to expedite the application to allowance and in no way affects the applicants' right to pursue the patentability of the subject matter contained in these claims.

Rejections under 35 U.S.C. § 103, Butler in view of Zhu and Blackwell

Claims 5, 6 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over US 5,928,726 (Butler) in view of US 5,608,003 (Zhu) and US 5,401,547 (Blackwell). Claim 9 was addressed previously.

Independent claims 5 and 6 include the limitation that the film of each claim is coated with an LAB using a particulate filler having an average particle size of at least 1 micron or greater. As discussed above with respect to claim 1, this element is not taught in either the Butler or Zhu reference. Since all the elements of claims 5 and 6 are not taught or suggested alone or in combination by either the Butler, Zhu or Blackwell references, the rejection of independent claim 7 is improper and should be withdrawn. Reconsideration and notice to that effect are respectfully requested.

Rejection under 35 U.S.C. § 112

Claims 1-10 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Specifically, the Office Action stated:

The phrase “average particle diameter of the particulate is greater than at least about 1 micron” is found to be new matter in the absence of any support for it in the specification.

Page 2, lines 3-7 of the specification as filed states:

LABs used in the present invention include at least one particulate filler, typically an inorganic filler, such as amorphous silica or alumina and *the diameter of the particles* is in the range of the topographical features of the textured film and the thickness of the LAB and *such diameter is typically in the range of 1 to 10 micrometers (emphasis added)*.

Thus, the specification as filed discloses a typical range of the particle diameter used in the LAB. This diameter range is called out as being in the range of 1 to 10 micrometers. A person of skill in the art would reasonably conclude that a typical particle size used in the inventive article for the typical LAB thickness would have a diameter of greater than about 1 micron. As specified in MPEP section 2163.02, “An objective standard for determining compliance with the written description requirement is, ‘does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed.’ *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ 2d 1614, 1618 (Fed. Cir. 1989).” Due to the direct disclosure of the subject matter added to the claims in the originally filed specification, a person of skill in the art would reasonably conclude that the inventor had possession of the claimed invention, as described in the specification at the time of filing. The rejection to claims 1-10 is overcome and should be withdrawn. Reconsideration, allowance, and notice to that effect is respectfully requested.

Respectfully submitted,

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